

### **REMARKS**

This responds to the Office Action dated July 5, 2007. By this response, claims 1, 9 and 16 were amended. Claims 17-20 were added. No claims were canceled. As a result, claims 1-20 are now pending in this application. Reconsideration and an early allowance is respectfully requested in view of the above amendments and the following remarks.

#### **Interview Summary**

Applicant thanks Examiner **Joseph W Drodge** for the courtesy of a telephone interview with Applicant's representative **Richard E. Billion**. It was determined in the interview that the Attorney did not have the entire office action. Applicant's attorney obtained pp 7 and 8 of the Office Action via Private PAIR.

#### **§112 Rejection of the Claims**

**A. Rejection:** Claims 1-15 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. According to the Examiner, the specification was "...deemed to not support claiming of the system as being 'tankless'." (See page 2 of the Office Action dated July 5, 2007).

**B. Response:** The specification supports the term "tankless" at page 3, lines 14-20 and at page 4, lines 1-4. Specifically, the specification states:

"...a high-flux membrane can be used for the RO elements of module 105. A module having a high-flux membrane eliminates the need for a permeate storage tank between the permeate outlet 118 and the faucet 122. Such a tank-less system emphasizes the need for flushing module 105 after use since the permeate comes directly from module 105 without being dissipated in a storage tank and re-filtered before being delivered to a user, such as in typical RO home systems." (See page 3, lines 14-20 and at page 4, lines 1-4 of the instant application).

As a result, the Examiner's rejection under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is overcome.

**C. Rejection:** Claims 1-15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**D. Response:** The specification supports the term “tankless” at page 3, lines 14-20 and at page 4, lines 1-4. The specification seems to define the term in the specification, as indicated by one of the references to the term tankless set forth above. It should be noted that the specification did spell the term differently than it appeared in the claim. In the specification, tankless was hyphenated. The Examiner’s rejection under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is incorrect since the original specification sets out the term and discusses the meaning of the term.

§102 Rejection of the Claims

**A. Rejection:** Claims 1, 4, 5 and 16 were rejected under 35 U.S.C. § 102(b) for anticipation by Ellis (U.S. Patent No. 4,629,568).

**B. Response:** Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, A[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*@ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Claim 1 recites “A tankless system...” It will be appreciated that there is support for this feature in the specification of the application. The specification states:

“In some embodiments, a high-flux membrane can be used for the RO elements of module 105. A module having a high-flux membrane eliminates the need for a permeate storage tank between the permeate outlet 118 and the faucet 122. Such a tank-less system emphasizes the need for flushing module 105 after use since the permeate comes directly from module 105 without being dissipated in a

storage tank and re-filtered before being delivered to a user, such as in typical RO home systems.” (Emphasis added--see page 3, lines 14-20 of the instant invention)

Applicant respectfully submits that the Examiner fails to make out a *prima facie* case of anticipation with respect to claim 1, since the Ellis III reference is not tankless. The Ellis III reference teaches two embodiments of a fluid treatment system. Both embodiments, shown in FIGs. 1 and 2, respectively, include a post filter element 62. According to the Ellis III reference, the first embodiment shown in FIG. 1 has the following:

“A post filter 62 is preferably disposed in the outlet conduit 28 and reduces the trace amounts of impurities that pass through the membrane and may for example be simply a charcoal canister and act as a taste and odor enhancer.” (See column 7, lines 19-23 of Ellis III)

According to the Ellis III reference, the second embodiment shown in FIG. 2 is described with respect to FIG. 1 as follows:

Pre and post filter elements 60, 62 are also included to treat the feed water and permeate, respectively, as described above. (See column 7, lines 51-53 of Ellis III)

As a result, the Ellis III reference fails to teach the invention as claimed since the outlet line between the reverse osmosis device and the faucet is filtered.

Claims 4 and 5 depend from claim 1 and include each limitation of their parent claim and are therefore also not anticipated by the cited reference. Moreover, Applicant previously amended claim 2 to recite: the various check valves and an automatic shutoff valve and the pressures which enable these elements. Such subject matter is not discussed in the cited reference.

With respect to claim, the Ellis III reference fails to teach each limitation recited in the claim. For instance, Applicant cannot find in the cited reference: delivering a permeate from a permeate outlet of a membrane module to a faucet and while delivering permeate to the faucet, not delivering permeate to a flush reservoir; after the faucet is closed, delivering permeate to the flush reservoir from the permeate outlet; and delivering the permeate in the flush reservoir to a feed water inlet of the membrane module to flush the membrane module. Therefore, claim 16

overcomes the rejection of claim 1 under 35 USC § 102(b) as being anticipated by Ellis (U.S. Patent No. 4,629,568). Reconsideration and allowance is respectfully requested.

§103 Rejection of the Claims

**A. Rejection:** Claims 3, 9, 10 and 12-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis (U.S. Patent No. 4,629,568) in view of Gramms et al. (U.S. Patent No. 5,512,167).

**B. Response:** In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 3 depends from claim 1 and includes the recitation of that claim by its dependency. Claim 1 recites a "tankless system". As set forth above, the Ellis patent does not teach this limitation. In fact it teaches just the opposite since it includes a post filter. The Gramms et al. reference does not cure this shortcoming. As a result, the Examiner has failed to make a proper *prima facie* case of obviousness since the prior art references fail to teach or suggest all the claim limitations.

Claim 9 also recites a tankless system. Again, Ellis does not teach or suggest this limitation. In fact it teaches just the opposite since it includes a post filter and furthermore, removing the post filter can be said to destroy the reference. The Gramms et al. reference does not cure this shortcoming. In addition, the fact that to come up with applicant's invention requires the removal of the post filter, is evidence that one would not combine these references. As a result, the Examiner has failed to make a proper *prima facie* case of obviousness with respect to claim 9 since the prior art references fail to teach or suggest all the claim limitations.

Claims 10, and 12-15 depend from claim 9 and include the limitations of that claim by their dependency. As a result, these claims also overcome the Examiner's rejection for the same reason as set forth above with respect to claim 9.

As a result, the Examiner's rejection of 3, 9, 10 and 12-15 under 35 U.S.C. § 103(a) as being unpatentable over Ellis (U.S. Patent No. 4,629,568) in view of Gramms et al. (U.S. Patent No. 5,512,167) is overcome.

**C. Rejection:** Claims 2, 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis (U.S. Patent No. 4,629,568) in view of Hart (U.S. Patent No. 6,110,360).

**D. Response:** Claims 2, 6 and 7 each depends from claim 1 and includes the recitation of that claim by their dependency. Claim 1 recites a tankless system. Ellis does not teach this limitation. The Gramms et al. reference does not cure this shortcoming. As a result, the Examiner has failed to make a proper *prima facie* case of obviousness with respect to claims 2, 6 and 7 since the prior art references fail to teach or suggest all the claim limitation.

**E. Rejection:** Claims 11 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis (U.S. Patent No. 4,629,568) in view of Gramms et al. (U.S. Patent No. 5,512,167) as applied to claims 8-10 above, and further in view of Hart (U.S. Patent No. 6,110,360).

**F. Response:** Claims 11 and 13 each depends from claim 9 and includes the recitation of that claim by their dependency. Claim 9 recites a tankless system. Ellis does not teach this limitation. The Gramms et al. reference does not cure this shortcoming. As a result, the Examiner has failed to make a proper *prima facie* case of obviousness with respect to claims 11 and 13 since the prior art references fail to teach or suggest all the claim limitation.

*Miscellaneous Remarks*

Claim 8 was indicated as allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph, set fourth in this Office Action and to include all the limitations of the base claims and any intervening claims. Claim 8 has been so written. The Examiner's indication of allowance is noted with appreciation.

**RESERVATION OF RIGHTS**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6977 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 2 day of October 2007.

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